



AFS
EFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Wolfgang Moderegger et al.

Application No.: 09/944,379

Filed: September 4, 2001

For: METHOD AND SYSTEM FOR
MANAGING INVITATIONS TO
BID

)
)
) Group Art Unit: 3627
)
) Examiner: Oger Garcia Ade
)
) Appeal No.: _____
)
)
)
)
)

APPEAL BRIEF

Mail Stop APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Primary Examiner dated July 19, 2007 finally rejecting claims 1-43, which are reproduced as the Claims Appendix of this brief.

- ☐ A check covering the ☐ \$ 250 ☐ \$ 500 Government fee is filed herewith.
- ☒ Charge ☒ \$ 250 ☐ \$ 500 to Credit Card. Form PTO-2038 is attached.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

08/21/2007 SZEWDIE1 00000113 09944379

01 FC:2402

250.00 0P

I. Real Party in Interest

AIS Management GmbH is the real party in interest, and is the assignee of Application No. 09/944,379.

II. Related Appeals and Interferences

The Appellant legal representative, or assignee, does not know of any other appeal, interferences or judicial proceeding, which will affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-43, 49-56 and 59 are pending in the application. Claims 49-56, and 59 have been withdrawn from further consideration in response to a Restriction Requirement. Claims 44-48, 57 and 58 have been canceled. All rejected claims are being appealed.

IV. Status of Amendments

There are no outstanding amendments that have not been entered. The claims were last amended in the amendment filed May 15, 2006.

V. Summary Claimed Subject Matter

As recited in the independent claims, the present application is directed to a computer-implemented method for fulfilling an invitation for bids of at least one performance to be effected by a bidder against payment (paragraph [0028], Figure 2). An exemplary system, as recited in the independent claim and illustrated in Figure 3, provides a database (element 27) comprising at least one performance description (elements 31 and 33) and a price description for each of the plurality of

predetermined performances (paragraph [0034], second sentence). After a user, i.e., buyer, purchaser, or person requesting a bid (Figure 1), has completed selection of at least one predetermined performance description, a list of unpriced performances desired by a user is generated (Figure 1, step 106, paragraph [0042]). The generated list of performances is unpriced meaning that a price is not generated with the list (paragraph [0045], third sentence).

The list of unpriced performances is forwarded to a plurality of bidders (paragraph [0045], Figure 3, element 37). The bidders upon receiving the list of unpriced performances, input or cause to have input a bid price into a bid mask (paragraph [0045], sixth sentence), where the bid price is assigned to at least one performance description of the list of unpriced performances. The bid price is a price to be paid to the bidder for the performance of the described work.

A bid is received from at least one of the plurality of bidders (Figure 1, step 114, Figure 3, element 39), each received bid including a bid price input to a bid mask (Figure 3, element 39) by the bidder and assigned to at least one performance description of the list of unpriced performances, the bid price stating the price to be paid to the bidder for effecting the respective performance by the bidder (Figure 3, element 43 and paragraph [0046]). The received bids are evaluated (Figure 1, step 114, paragraph [0047], Figure 7 and paragraphs [0049]-[0052]) and a bid is selected from the bids received (Figure 1, elements 116, 118 and 120).

The database (Figure 3, element 27) is updated (Figure 3, arrow 55,) such that, for each performance of the generated list of performances for which a bid is selected, the price description in the database corresponding to said performance is

modified to reflect the selected bid, wherein at least the updating is performed by a computer (paragraph [0055]).

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 1-3, 7-10, 13-15, 18, 19, 26, 33, 38-41, and 43 have been rejected under 35 U.S.C. §102(e) as being anticipated by Fields (U.S. Patent Application Publication No. 2002/00069154). Claims 4-6, 10-12, 16, 20, 21, 34-36, 42 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fields. Claims 17, 27-32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fields in view of Slaight et al. (U.S. Patent Application Publication No. 2002/0077954). Claims 22-25 and 37 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fields in view of Vashistha et al. (U.S. Patent Application Publication No. 2001/0051913).

VII. Argument

A. Advisory Action mischaracterizes the claimed feature "unpriced performances" as non-functional descriptive material.

In making the rejection of independent claim 1 in the final Office Action, the rejection did not address Appellants amended language of "unpriced performances". In response to Appellants' Request for Reconsideration, the Office asserted in the Advisory Action that the newly added claim language was non-functional descriptive material and afforded no patentable weight.

The claimed "list of unpriced performances desired by a buyer" describes the data and information derived from a database that is exchanged between a buyer and a potential bidder. The Appellants respectfully submit that in the context of a

business method and process claim, the characterization, by the Examiner, of the "list of unpriced performances desired by a buyer" as non-functional descriptive material is misplaced.

The list of unpriced performances facilitates an interaction between the buyer, who generated the list, and the bidder, who receives the data and information derived from the database, and must input numbers based on what the bidder expects to be paid for completing the listed performance.

The forwarded list of unpriced performances must have areas where data is input, which when the data is input, particularly in the context of a computer, structurally changes the list. The inputted data also creates an interrelationship between the list of performances desired by the buyer and the prices input by the bidder.

The fact that the list is of unpriced performances also effects the information flow and reactions by the participants, thus leading to concrete and tangible results

Therefore, the Appellant respectfully submits that the list of unpriced performances imparts functional elements because the claimed elements need the requisite function for the performance of the claimed method. See MPEP §2106.

B. Alleged Non-Functional Descriptive Material is the basis for a 35 U.S.C. §101 rejection, not a prior art rejection.

In the Advisory Action, the Examiner asserts that the newly claimed feature of "list of unpriced performances" is merely non-functional descriptive material because it neither "enhances nor diminishes" the functionality of the system. As pointed out

above, this is not the case. The Advisory Action further states that the alleged descriptive material is not given any patentable weight.

Appellant respectfully submits that the assertion of "non-descriptive functional material" invokes the area of law dealing with compliance with a 35 U.S.C. §101 rejection, but is not relevant to a prior art rejection.

MPEP §2106 (VII) states:

Once USPTO personnel have concluded the above analyses of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102 and 103, they should review all the proposed rejections and their bases to confirm that they are able to set forth a *prima facie* case of unpatentability. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the findings, conclusions and reasons which support them.

Appellant respectfully submits that the claims have not been properly rejected under any of 35 U.S.C. §§101, 112, 102 or 103. Therefore, the rejection in the final Office Action should be overruled.

Even if the amended claim language were rejected under 35 U.S.C. §101, all claim limitations must be considered when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983).

The invention in *Gulack* was directed to a hat band-like device imprinted with a cyclic series of numbers for educational and recreational purposes.

In re Gulack further states:

Differences between an invention and prior art cited against it cannot be ignored merely because those differences reside in content of printed matter. Under Section 103, the board cannot dissect a claim, excise printed matter from it, and declare

remaining portion of the mutilated claim to be unpatentable. The claim must read as whole. (emphasis added).

217 USPQ at 403.

In the final Office Action, the Examiner did not provide any response to the Appellant's arguments regarding the prior art or consider all of the claim limitations, as required by *In re Gulack*, when making the final prior art rejection. Therefore, the Appellant requests that the rejections in the final Office Action be overruled.

C. The Fields publication does not disclose or suggest all of the features recited in the claims.

As the Board is aware, one criteria for establishing a *prima facie* case of obviousness is that all features of the claimed invention be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Even assuming, *arguendo*, that the "unpriced performance" is descriptive material, Appellant submits that the Fields publication still does not disclose or suggest all of claimed features. For example, Fields publication does not disclose or suggest receiving a bid from at least one of the plurality of bidders, each received bid including a bid price input to a bid mask by the bidder.

The Fields Publication describes a system where the attorney, who receives the request for proposal (RFP), can only accept, reject or delete the RFP. The attorney (bidder) can not input a bid price into a bid mask as recited in the independent claim. As shown in Figure 3 of the Fields Publication, the attorney from Attorney Start Page 56B can only view the RFP (block 60) and either Accept or Remove the RFP (block 62). The bidder attorney cannot enter a bid price into a bid mask as recited in the independent claim.

D. Improper rejection of dependent claims 3, 12, 22, 23 and 38.

Dependent claim 3 further limits the "generating" and "updating" steps of independent claim 1 by reciting the step of generating the list of performances includes modifying at least one performance description in the list of performances, and wherein updating the database includes automatically updating the price description corresponding to bid performances whose performance description was not modified.

On pages 3 and 4 of the final Office Action, the Examiner asserts that the Start Page 56A that permits the client to renew and delete requests for proposal as described in paragraph [0062] of the Fields publication discloses the updating feature recited in claim 3 and the features recited in claim 12.

However, in the rejection of claim 1, the generating step of claim 1 is allegedly disclosed by paragraphs [0093], [0019], [0024], and [0067]. Only paragraph [0024] from those cited specifically discuss functions performed by the client, but these functions are unrelated to the "generating" and "updating" steps of claim 3. Paragraph [0067] refers to the bidder attorney.

Paragraph [0024] merely describes a means for assisting a client in formulating a request for proposal. Paragraph [0067] refers to the functions performed by Attorney Start Page 56B. By citing the portion of paragraph [0062] in the final rejection of claim 3, the Examiner is implying that features of claim 3 are performed by the bidder attorney via Attorney Start Page 56B. This contradicts the earlier identification of Start Page 56A as performing the generating step.

As for the claimed step of updating the database includes automatically updating the price description corresponding to bid performances whose performance description was not modified, the cited portion of the Fields publication does not refer to a database.

Claim 12 recites wherein updating the price description is carried out independently from the at least one regionally dependent price correction term. However, in the rejection, there is no discussion of the claim language or any citation to the Fields publication that allegedly discloses the recited claim language

Appellant respectfully submits that claims 3 and 12 are not anticipated or rendered obvious by the Fields publication, and requests that the rejections of claims 3 and 12 be overruled.

Claim 14 recites, in combination of features of claim 13, determining a plurality of bidders to which to forward the list of performances is based on a history of past performance by the bidders. The Fields publication does not address the feature of claim 14. As best understood by the Appellants, the Fields publication at paragraph [0093] allows a client to choose predetermined lists of attorneys, but it does not disclose that the selection of the predetermined list of attorneys is based on past performance by those attorneys as recited in claim 14.

Claims 22 and 23 were rejected over the combination of the Fields publication and the U.S. Patent Application Publication 2001/0051913 to Vashishta et al. under 35 U.S.C. §103(a). Claims 22 and 23 recite wherein evaluating the received bids based on criteria comprising lowest price, estimated price, ideal price, deviation from the ideal price, and bidder performance information, and wherein evaluating the received bids includes generating an ideal bid for each performance description of

the list of performances, the ideal price being automatically determined as the minimum bid price assigned to the respective performance description, respectively.

On page 11 of the Final Office Action, the Examiner states that all of the features recited in claims 22 and 23, among others, are disclosed in either the Abstract or paragraph [0090] of the Vashistha publication. However, neither the Abstract nor paragraph [0090] of the Vashistha publication disclose or refer to the specific features recited in claims 22 and 23.

The Office Action also does not have any explanation of why one of ordinary skill in the art would combine the teachings of the Fields publication with the teachings of the Vashistha publication to arrive at Appellants' claims 22 and 23.

Appellants respectfully submit that neither the Fields publication nor the Vashistha publication, either individually or in combination, disclose all of the features, in combination with independent claim 1, recited in claims 22 and 23.

Accordingly, Appellants request that the rejection of claims 22 and 23 be overruled.

As for claim 38, the final Office Action, while referring to the claim in the statement of rejection, does not substantively address the claim. Appellants respectfully request that the rejection of claim 38 be overruled because the subject matter of the claim has not been properly addressed by the Office.

F. Conclusion

Appellants respectfully submit that the claims recite statutory subject matter and that all features of the claims are not disclosed or suggested by the applied prior

art. Appellants request that the rejections of record be overruled, and a notification of allowance be issued.

VIII. Claims Appendix

See attached Claims Appendix for a copy of the claims involved in the appeal.

IX. Evidence Appendix

None.

X. Related Proceedings Appendix

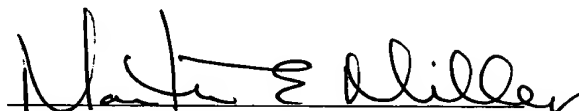
None.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date August 20, 2007

By:



Martin E. Miller

Registration No. 56022

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620

Table of Contents

	Page
I. Real Party in Interest.....	2
II. Related Appeals and Interferences	2
III. Status of Claims	2
IV. Status of Amendments.....	2
V. Summary Claimed Subject Matter.....	2
VI. Grounds of Rejection to be Reviewed on Appeal.....	4
VII. Argument	4
VIII. Claims Appendix	11
IX. Evidence Appendix	22
X. Related Proceedings Appendix.....	23



VIII. CLAIMS APPENDIX

The Appealed Claims

1. A computer-implemented method for fulfilling an invitation for bids of at least one performance to be effected by a bidder against payment, comprising:
 - providing a database, comprising at least one performance description and at least one price description for each of a plurality of predetermined performances;
 - generating a list of unpriced performances desired by a buyer by selecting at least one of the predetermined performances from the database and by including the respective performance description in the list of performances;
 - forwarding the list of unpriced performances to a plurality of bidders;
 - receiving a bid from at least one of the plurality of bidders, each received bid including a bid price input to a bid mask by the bidder and assigned to at least one performance description of the list of unpriced performances, the bid price stating the price to be paid to the bidder for effecting the respective performance by the bidder;
 - evaluating the received bids and selecting a bid from the bids received; and
 - updating the database such that, for each performance of the generated list of performances for which a bid is selected, the price description in the database corresponding to said performance is modified to reflect the selected bid, wherein at least the updating is performed by a computer.
2. The method according to claim 1, wherein the step of updating the database is performed automatically.

3. The method according to claim 1, wherein generating the list of performances includes modifying at least one performance description in the list of performances, and wherein updating the database includes automatically updating the price description corresponding to bid performances whose performance description was not modified.

4. The method according to claim 3, wherein the modified performance description comprises a new performance description which is stored in the database as an additional predetermined performance.

5. The method according to claim 1, wherein when generating the list of performances at least one performance description is added for a performance not contained in the data base, and wherein the step of updating the database is carried out automatically only for the performance descriptions which were not added.

6. The method according to claim 5, wherein the added performance descriptions comprises a new performance description which is stored in the database as an additional predetermined performance.

7. The method according to claim 1, wherein the step of generating the list of performances also includes generating an estimated bid which includes an estimated price for at least one desired performance of the a generated list of performances.

8. The method according to claim 7, wherein the estimated bid is generated automatically.

9. The method according to claim 7, wherein the estimated price is determined from the price description assigned to the performance.

10. The method according to claim 9, wherein the price description of the performance in the database comprises prices independent of the region in which the predetermined performance is to be effected, and wherein the database further comprises at least one regionally dependent price correction term for a plurality of regions in which the predetermined performance is to be effected.

11. The method according to claim 10, wherein the generated list of performances comprises a description for at least one place at which the performances described by the performance descriptions in the list of performances are to be effected, and wherein the estimated price is determined from the regionally independent prices and the at least one regionally dependent price correction term.

12. The method according to claim 11, wherein updating the price description is carried out independently from the at least one regionally dependent price correction term.

13. The method according to claim 1, wherein forwarding the list of performances includes determining a plurality of bidders to which to forward the list of performances.

14. The method according to claim 13, wherein determining a plurality of bidders to which to forward the list of performances is based on a history of past performance by the bidders.

15. The method according to claim 13, wherein forwarding the list of performances to the bidders after generating the list of performances and after determination of the plurality of bidders is performed automatically.

16. The method according to claim 1, wherein the list of performances is secured against modification upon the completion of the list of performances.

17. The method according to claim 1, wherein receiving bids includes receiving several bids from each of several bidders, with the last bid received from each bidder being used for bid evaluation and selection.

18. The method according to claim 1, wherein a submission deadline is determined and no bid is accepted after the submission deadline.

19. The method according to claim 18, wherein, prior to the submission deadline, and in response to a respective inquiry from the buyer, any received bids are disclosed to the buyer.

20. The method according to claim 18, wherein, prior to the submission deadline, and in response to a respective inquiry from the buyer, any received bids are not disclosed to the buyer.

21. The method according to claim 19, wherein the disclosed bid includes the time of receipt of the disclosed bid.

22. The method according to claim 1, wherein evaluating the received bids is based on criteria comprising lowest price, estimated price, ideal price, deviation from the ideal price, and bidder performance information.

23. The method according to claim 1, wherein evaluating the received bids includes generating an ideal bid for each performance description of the list of performances, the ideal price being automatically determined as the minimum bid price assigned to the respective performance description.

24. The method according to claim 23, wherein a deviation from the ideal price is automatically determined for the bid price of each performance description of a received bid.

25. The method according to claim 1, wherein evaluating the received bids includes an automatic determination of a most favorable bid in which the total of the bid prices for the most favorable bid represents a lowest price compared to the remaining bids.

26. The method according to claim 7, wherein a synthetic price is generated from at least one estimated price as calculated from the price descriptions assigned to the respective performance description.

27. The method according to claim 7, wherein a synthetic price is generated from at least one ideal price as calculated from the bid prices assigned to the respective performance descriptions as their lowest quoted price.

28. The method according to claim 27, wherein the generated synthetic price is made available to a number of chosen bidders for inspection, and wherein each of the chosen bidders can submit modifications of their respective bid prices.

29. (Original) The method according to claim 28, wherein the synthetic bid is repeatedly calculated anew depending on the modifications and is made available for inspection by the chosen bidders.

30. (Original) The method according to claim 27, wherein an auction end time is determined after which modifications to the bids are no longer accepted.

31. The method according to claim 1, wherein after receiving the bids from a plurality of submitting bidders, the bids are made available to a chosen few of the submitting bidders such that each of the chosen bidders can inspect the bids of the remaining chosen bidders, and wherein each of the chosen bidders can submit modifications of their respective bid prices.

32. The method according to claim 31, wherein an auction end time is determined after which modifications can no longer be received.

33. The method according to claim 1, wherein after selecting the bid, the bidder who submitted the selected bid is automatically informed of the selection.

34. The method according to claim 1, wherein after selecting the bid, the bidders whose bids were not chosen, are automatically informed that their bids have not been selected.

35. The method according to claim 1, wherein after selecting the bid, a contract list of performances is generated automatically.

36. The method according to claim 35, wherein the contract list of performances is forwarded automatically to the bidder whose bid was selected.

37. The method according to claim 1, wherein selecting a bid is performed automatically.

38. The method according to claim 1, wherein the buyer is given access to at least a part of the database, and the buyer generates the list of performances at least partially from information in the database.

39. The method according to claim 38, wherein the received bids are stored and, after the submission deadline, are automatically transmitted to the buyer.

40. The method according to claim 38, wherein the buyer selects a bid from the bids received.

41. The method according to claim 38, wherein for a plurality of buyers, a separate database is reserved for each of said plurality of buyers.

42. The method according to claim 1, wherein the price description comprises a guiding performance description and a description of a specified rate of exchange per hour, wherein the guiding performance description states the amount of performance to be effected per hour, and wherein the hourly rate states the amount

per hour to be paid to the bidder for the amount of performance per hour stated in the guiding performance description.

43. The method according to claim 1, wherein the price description comprises a plurality of bid prices from bids accepted in the past.



IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.